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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,582	09/15/2003	Lonnie F. Gary	09230 84913	9323
20873	7590	10/13/2005		
LOCKE LIDDELL & SAPP LLP ATTN: SUE COTT 2200 ROSS AVENUE SUITE 2200 DALLAS, TX 75201-6776			EXAMINER GROSSO, HARRY A	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,582

Applicant(s)

GARY, LONNIE F.

Examiner

Harry A. Grosso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/15/03 & 8/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election with traverse of the species of Group 1, Figures 1-4, 6, in the reply filed on July 19, 2005 is acknowledged. The traversal is on the ground(s) that new claims 23-24 and 27-28 are generic and allowable. This is not found persuasive because the claims are not allowable in view of the action below. Also claims 23-24 and 27-28 are considered to be subcombination claims common to each of the species rather than generic claims (See MPEP 806.04(d)). Applicant asserts that a prima facie case that the identified groups are independent or distinct from each other has not been established. In response applicant's disclosure shows the species to be independent inventions, therefore a prima facie case has been established. Applicant maintains that examination of all species would not require additional time or effort as compared to examination of the elected species. . In response, significant additional time and effort would be required to search and examine elements in the non-elected species and to address the additional claims represented by the non-elected species. The additional time is considered to constitute a serious burden as defined in the MPEP.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9 and 16-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 13 recites the limitation "the polymeric material" in the first line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rains (3,556,341).

6. Regarding claim 23, Rains discloses a beverage holder having side walls, a bottom, an open top and an interior cavity into which a beverage container is receivable, and one portion of the side wall is substantially flat with a magnet disposed in the side wall facing outwardly (Figures 1-3, column 1, lines 70-72, column 2, lines 23-28).

7. Regarding claim 25, Rains discloses a magnet disposed in the bottom wall of the holder (40, Figure 1, column 2, lines 17-19).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1–6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rains (3,556,341) in view of Yu (6,390,319).

10. Regarding claims 1 and 3, Rains discloses a beverage holder having side walls, a bottom and an interior cavity into which a beverage container is receivable, and one portion of the side wall is substantially flat with a magnet disposed in the side wall providing a substantially planar side wall surface (Figures 1-3, column 1, lines 70-72, column 2, lines 23-28). Rains does not teach that the beverage holder is insulated or that the magnet is disposed between the inner and outer side wall sections. Yu discloses a beverage holder having insulated walls and a magnet embedded in the side wall between the inner and outer sections (Figure 3, column 3, lines 28-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of insulated walls with the magnet embedded into the walls as disclosed by Yu in the beverage holder disclosed by Rains to provide insulation for preventing rapid temperature change in the contents and a method of installing the magnet in the holder that would prevent detachment.

11. Regarding claim 2, Rains discloses a magnet disposed in the bottom wall of the holder (40, Figure 1, column 2, lines 17-19).

12. Regarding claim 4, Rains discloses the magnet is disk shaped (Figures 1 and 3).

13. Claim 5 recites that the magnet is round and has a diameter of about 5 cm.

Applicant has not disclosed that this shape and size requirement solves any stated problem or is for any particular purpose, appearing to be a design choice. It appears

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magnets of a variety of sizes and shapes would be inherently capable of performing as required. The holder of Rains has a round magnet and would be inherently capable of being produced with a magnet meeting the size requirement if deemed desirable.

14. Claim 6 recites that the magnet is round and has a thickness of about 3 mm.

Applicant has not disclosed that this shape and size requirement solves any stated problem or is for any particular purpose, appearing to be a design choice. It appears magnets of a variety of sizes and shapes would be inherently capable of performing as required. The holder of Rains has a round magnet and would be inherently capable of being produced with a magnet meeting the size requirement if deemed desirable.

15. Claims 1, 7, 10-15, 23, 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Rains.

16. Regarding claims 1, 7, 23, 24 and 26, Yu discloses an insulated beverage holder having side walls, a bottom and an interior cavity into which a beverage container is receivable, and one portion of the side wall with a permanent magnet disposed in the side wall between the inner and outer side wall sections (inner and outer shells) (Figure 3, column 3, lines 28-45). Yu does not teach that a portion of the side wall is substantially flat with the magnet disposed in the side wall, providing a substantially planar side wall surface for attaching the holder to a vertical ferrous metal surface. Rains discloses a holder with a portion of the side wall that is substantially flat with the magnet disposed in the side wall, providing a substantially planar side wall surface for attaching the holder to a vertical ferrous metal surface (Figures 1-3, column 2, lines 23-28). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have incorporated the use portion of the side wall that is substantially flat with the magnet disposed in the side wall as disclosed by Rains in the beverage holder disclosed by Yu to provide a substantially planar side wall surface for attaching the holder to a vertical ferrous metal surface.

17. Regarding claims 10 and 11, the beverage holder of claim 1 is disclosed as discussed in paragraph 12 above. The examiner considers the phrases "insert molded" and "dip molded" to be product by process limitations that do not materially affect structure.

18. Regarding claims 12-15, 27 and 28, Yu discloses that the holder is a unitarily formed cylinder made of foamed polymeric material (column 3, lines 30-32).

19. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Rains as applied to claim 7 above, and further in view of Tyson (5,699,631). The beverage holder of claim 7 is disclosed as discussed in paragraph 12 above, however, Yu and Rains do not teach the use of a specific material for the permanent magnet. Tyson discloses an article intended to be attached to a vertical ferrous metal surface using a magnet comprised of barium ferrite or strontium ferrite because such magnets are flexible and commercially available (column 6, lines 15-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a magnet comprised of barium ferrite or strontium ferrite as disclosed by Tyson in the beverage holder disclosed by Yu since such magnets are flexible and commercially available.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barfield (2004/0084593 A1), Mitchell (2004/0173719 A1) and Barnett (2003/0047578 A1) disclose magnetic container holders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nathan Newhouse
Supervisory Patent Examiner
Art Unit 3727

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